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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 10/054,517 | 11/13/2001 | Miksa Marton | 04004.003 | 4778 |
| 7590 | 01/30/2004 | | EXAMINER | |
| Christopher J. Fildes Fildes & Outland, P.C. 20916 Mack Avenue, Suite 2 Grosse Pointe Woods, MI 48236 | | | SHAKERI, HADI | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3723 | |
| | | | DATE MAILED: 01/30/2004 | |

b

Please find below and/or attached an Office communication concerning this application or proceeding.

NK

| | | | |
|------------------------------|---------------------------------|-------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/054,517 | MARTON, MIKSA | |
| | Examiner Hadi Shakeri | Art Unit 3723 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
 - 4a) Of the above claim(s) 4-8 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 13 November 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

| | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION***Election/Restrictions***

1. This application contains claims 4-8 drawn to an invention nonelected without traverse in Paper No. 03. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

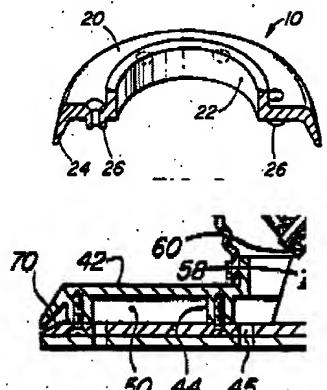
Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Marton.

Marton discloses all the limitations of claim 1, i.e., a suction ring (10) disposed between a sanding pad assembly (12) and the suction housing (14) comprising a circumferential sidewall (70) including first and second edges, one (the upper one) defining an opening and adapted to mount to the pad assembly (44); a circular back wall (42), being continuous with the other of the edges (as well as the first one) and having an opening (30 Figs. 1, 2) (defined by flange 52, Fig. 5) for communicating the vacuum pressure from the housing to the pad assembly, however, in the alternative, since the leg (44) shown in the embodiment of Fig. 5, does not define a countersunk hole as disclosed in the embodiments of Figs. 1-3 for legs (26) (27), even though all limitations as describe above is disclosed in one reference, the claimed invention as recited in claim 1, would have been obvious by providing the leg (44) with the countersink hole on top, as disclosed by Figs. 1-3, as another means of coupling the ring with the pad assembly, depending on the operational parameters, e.g., cost.

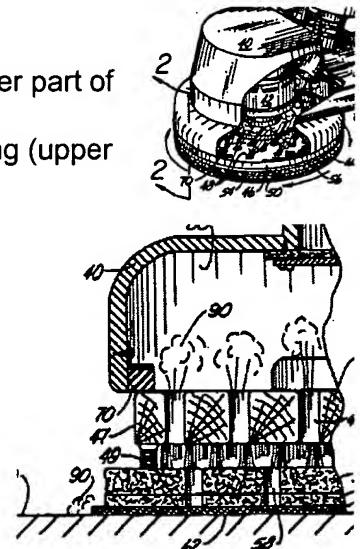


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4. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takashima, US Patent No. 5,027,470.

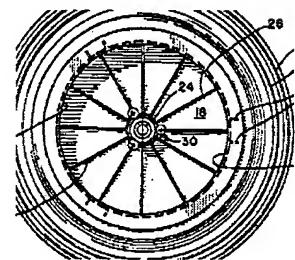
Takashima discloses all the limitations of claim 1, i.e., a suction ring (lower part of 40) disposed between a sanding pad assembly (44) (52), and the suction housing (upper part of 40 surrounding the motor) comprising a circumferential sidewall including first and second edges, one defining an opening (sealed by 70), and adapted to mount to the pad assembly, i.e., (44); a circular back wall (meeting the upper part), being continuous with the other of the edges, since rotatable shaft with an off-set portion as recited in the preamble is not linked into the body of the claim, Takashima is considered to meet all the limitations of claim

1, however, in the alternative the housing and structures of the invention of Takashima with an off-center shaft, e.g., orbital sander, depending on the intended use and/or operational parameters, modification within the knowledge of one of ordinary skill in the art, would meet all the limitations of the claim.



5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Marton or Takashima in view of Kitahata.

Both Marton and Takashima meet all the limitations of claim 2, except for ribs radially disposed and extending from the sidewall to the like plurality of legs. Kitahata teaches buffer pad assembly having a plate (18) reinforced with radially extending ribs (26). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of Marton and/or Takashima with reinforcing ribs as taught by Kitahata to stiffen the ring, e.g., in application wherein a weaker material is used for the housing, e.g., syntactic resin, aluminum...depending on the operational and/or cost parameters.



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6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Marton or Takashima.

Regarding claim 3, both Marton and Takashima disclose the claimed invention except for the use of the specific materials. It would have been obvious to one having ordinary skill in the art at the time the invention was made to aluminum for its desired properties, e.g., light weight, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

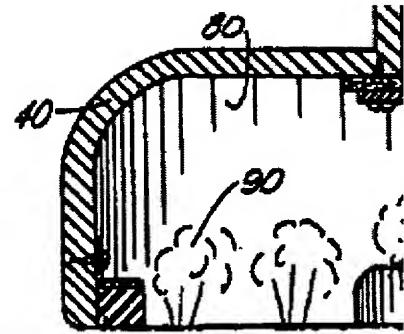
7. Applicant's arguments filed 11/20/03 have been fully considered but they are not persuasive.

The argument regarding Marton that it includes structure distinct from the present invention fails to point out how it does not meet the limitations as recited, it is noted that the features upon which applicant relies (i.e., attachment at a bottom end or a lower edge) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims recited for one of the edges to include opening for attachment with the pad, which as explained above is met by the countersink holes for the legs at the upper edge. The suction ring of Marton does include a back wall having an opening (30) Figs. 1 and 2 or as defined by rim (52) Fig. 5.

The argument against Takashima is not persuasive since lacking any structural limitations and/or structural relationship to distinguish between a "housing" and a "suction ring" the integral housing and suction ring as disclosed by Takashima and described above meets the limitations as recited. The circular disc portion (46), i.e., the driving disc, is not the element

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or structure meeting the limitation of the suction ring, but as described in the previous and this Office Action, the lower part of the housing (40), i.e., the part integral with the vertical part as shown in Fig. 2, meets the limitations as recited for the suction ring. It includes a circumferential side wall, a circular back wall and an opening in an edge of the side wall, i.e., either the opening that is sealed with (70) or the opening that attaches the seal to the side wall, i.e., the opening accommodation the screw. It is further noted that it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.



The argument that ribs in Kitahata stiffens the hub and not the entire suction ring and the pad assembly is not persuasive, since the teaching from Kitahata to one of ordinary skill in the art is the use of ribs to stiffen a structure, and the argument that adding ribs to the suction ring of Marton would not achieve the same result, is not persuasive, since for the embodiments as shown in Fig. 5, i.e., suction rings having a relatively large outer radius, could be reinforced with ribs to stiffen the structure.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hadi Shakeri at (703) 308-6279, FAX (703) 746-3279 for unofficial documents. The examiner can normally be reached on Monday-Thursday, 7:30 AM to 6:00 PM. All official documents may be faxed to (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1148.



Hadi Shakeri
Patent Examiner
January 28, 2004